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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,718	03/18/2004	Kevin Eugene Dombkowski	LUC-469/Dombkowski 11-16	6988
32205 7590 04/07/2009 PATTI, HEWITT & AREZINA LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER YALEW, FIKREMARIAM A	
			ART UNIT 2436	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,718	Applicant(s) DOMBKOWSKI ET AL.	
	Examiner Fikremariam Yalew	Art Unit 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The office action is in replay to an amendment filed on 03/26/2009. Claims 1-27 are pending.

Response to Arguments

2. **Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive because claims 26-27 are not examined on the previous final office action and, therefore, the finality of that action is withdrawn. However in view of the new claim amendments by applicant the examiner made final.**

3. Regarding to the applicant's argument respect to a new matter, please see 112 rejections below.

4. Applicant's arguments with respect to claims 1-27 have been considered but are not persuasive. Applicant argues the combination of Karaoguz and Maknezie reference fails to disclose or suggest "wherein one or more private keys employable for encryption and/or decryption of information are erased **via cutoff of power** upon an attempt to move the authentication device". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of Karaoguz and Mackenzie teach one or more private keys employable for encryption and/or decryption of information are erased upon attempt to move the authentication device (See col. 4 lines 44-47 and col. 12 lines 6-16). The examiner acknowledged the Karaoguz and Makenzie reference of the prior art do not explicitly teach **key information are erased via a cutoff power.**

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However, Niimura reference teaches key information are erased via cutoff power (See Fig 3 steps S303, S304 and col. 4 lines 21-25), that's why the examiner require to combine the Niimura reference within the combinations of Karaoguz and Mackenzie reference. Examiner asserts that the combinations of Karaoguz-Mekenzie-Niimura teach the claim limitations and therefore the rejection is respectfully maintained.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 14, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention or teach **an automatic** cutoff. The applicant should explicitly explain how the specification supports the new added claim limitations such as **an automatic** cutoff.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 8-18, 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaoguz (US Pub No 2004/0059914 A1) in view of Mckenzie et al (hereinafter referred as Mckenzie) US Pub No 2002/0141594 and further in view of Niimura et al (hereinafter referred as Niimura) US Patent No 7,420,596 B2 and further in view of Williams (US Patent No 7,139,920 B2).

9. As per claims 1, 14, 22: Karaoguz discloses an apparatus/method/article, comprising: an authentication device that authenticates a computing device (See 0041 0049), in communication with the authentication device, through employment of a determination that a current location of the authentication device matches an initial location of the authentication device (See Fig 3 steps 305,310,335 and Fig 4 steps 440 and 0019).

Karaoguz does not explicitly teach wherein one or more private keys employable for encryption and/or decryption of information are erased upon an attempt to move the authentication device. However Mackenzie teaches wherein one or more private keys employable for encryption and/or decryption of information are erased upon an attempt to move the authentication device (See col. 4 lines 44-47 and col. 12 lines 6-16)

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to modify the teaching method of Mackenzie within Karouguz method in order to provides techniques to render the private key of a networked device invulnerable to offline dictionary attacks, even if the devices captured(See MacKenzie 0034).

The combination of Mackenzie and Karouguz do not explicitly teach information are erased via a cutoff power.

However Niimura teaches information are erased via an automatic cutoff power (See Fig 3 step S303, S304 and col. 4 lines 21-25)

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to modify the teaching method of Niimura within Mackenzie and Karouguz method in order to prevent a leak of the key data (See Niimura col. 4 lines 24-25).

Mackenzie-Karouguz-Niimura do not explicitly teach an automatic cutoff power. However Williams teaches an automatic cutoff power (See col. lines 18-24).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Williams within the combinations of Mackenzie-Karouguz-Niimura method in order to yield predictable results.

10. As per claim 2: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the computing device comprises a first computing device wherein the authentication device makes the determination that the current location of the authentication device matches the initial location of the authentication device in response to a request from a second computing device for authentication of the first computing device for a data transfer from the second computing device to the first computing device (See Karaoguz 0008,0019-0020).

11. As per claims 3,15: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus/method wherein the request from the second computing device comprises an authentication challenge string (See Karaoguz 0038,0041); wherein the authentication device stores one or more private keys, wherein if the current location of the authentication device matches the initial location of the authentication device, then the authentication device employs

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one or more of the one or more private keys to decrypt the authentication challenge string into an authentication challenge response(See Karaoguz 0038).

12. As per claims 4,16: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus/method wherein the authentication device sends the authentication challenge response to the second computing device, wherein the second computing device analyzes the authentication challenge response to determine whether the first computing device is authenticated for the data transfer (See Karaoguz 0037-0038).

13. As per claims 5,17: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus/method wherein the second computing device comprises an authentication challenge key to compare with the authentication challenge response received from the authentication device (See Karaoguz 0038,0041); wherein if the authentication challenge response matches the authentication challenge key, then the authentication challenge response represents that the first computing device is authenticated and the data transfer can be sent from the second computing device to the first computing device(See Karaoguz Fig 4 step 440 and 0038,0041).

14. As per claims 6,18: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein upon determination that the current location of the authentication device does not match the initial location of the authentication device, the authentication device prevents authentication of the first computing device and disables the one or more private keys (See Karaoguz Fig 4 step 450 and 0042).

15. As per claim 8, 20: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus/method wherein the authentication device comprises a base portion, a cover

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portion, and one or more electronic components that serve to authenticate the computing device; wherein the base portion is fixed to a surface near the computing device, wherein the cover portion is fixed to the base portion to provide a secure shell for the one or more electronic components (See Karaoguz Figs 2, 3 and 0017, 0050).

16. As per claim 9,21: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus/method wherein a first one of the base and cover portions receives electricity through a power port, wherein a second one of the base and cover portions receives electricity through an electrical contact with the first one of the base and cover portions(See Fig 5 step 515,525); wherein upon separation of the second one of the base and cover portions from the first one of the base and cover portions, the second one of the base and cover portions loses power and prevents authentication of the computing device(See Karaoguz Fig 5 step 515,525).

17. As per claim 10: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach wherein the second one of the base and cover portions electrically supports one or more of the one or more electronic components that store one or more private keys, wherein the authentication device employs one or more of the one or more private keys to authenticate the computing device (See Karaoguz Fig 5 step 515,525); wherein a loss of power in the second one of the base and cover portions erases the one or more private keys from the one or more of the one or more electronic components(See Karaoguz Fig 5 step 515,525).

18. As per claim 11: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the authentication device comprises a location sensor (See 0039); wherein upon initialization of the authentication device, the location sensor sets the initial location of the authentication device (See Karaoguz 0039,0045); wherein the location sensor determines the

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current location of the authentication device, wherein the authentication device compares the current location with the initial location to authenticate the computing device (See Karaoguz 0039,0045).

19. As per claim 12: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the location sensor comprises a global positioning system component, wherein the global positioning system component measures the initial location and the current location of the authentication device as a three-dimensional location of latitude, longitude, and altitude (See Karaoguz 0045-0046).

20. As per claim 13: the combinations of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the authentication device allows authentication of the computing device upon the determination that the authentication device matches the initial location of the authentication device within a specified error message (See Karaoguz 0039, 0045)

21. As per claim 23: the combination of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the one or more private keys are erased upon an attempt of open the authentication device (See Mackenzie col. 4 lines 44-47 and col. 12 lines 6-16)

22. As per claim 24: the combination of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the one or more private keys are erased via an automatic cutoff of power upon the attempt to move the authentication device (See Mackenzie col. 4 lines 44-47 and col. 12 lines 6-16 and See Niimura Fig 3 step S303,S304 and col. 4 lines 21-25).

23. As per claim 25: the combination of Karaoguz-Mackenzie-Niimura-Williams teach wherein the one or more private keys are erased via an automatic cutoff of power upon an

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attempt to open the authentication device (See Niimura See Fig 3 step S303, S304 and col. 4 lines 21-25)

24. As per claim 26: the combination of Karaoguz-Mackenzie-Niimura teach the apparatus wherein the current location comprises a network (See 0009 and Fig 2 step 205).

25. As per claim 27: the combination of Karaoguz-Mackenzie-Niimura-Williams teach the apparatus wherein the current location comprises a room (See Karaoguz 0009 Fig 2 step 205).

26. Claims 7, 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karaoguz (US Pub No 2004/0059914 A1) in view of Mckenzie et al (hereinafter referred as Mckenzie) US Pub No 2002/0141594 and further in view of Niimura et al (hereinafter referred as Niimura) US Patent No 7,420,596 B2 and furthermore Williams (US Patent No 7,139,920 B2) and furthermore in view of Wheeler et al (US Pub No 2007/0088950 A1).

27. As per claims 7, 19: the combination of Karaoguz-Mackenzie-Niimura-Williams teach claims 6 and 15 as recited above. Karaoguz-Mackenzie-Niimura-Williams do not explicitly teach the apparatus wherein the authentication device stores the one or more private keys in volatile memory, wherein upon determination that the current location of the authentication device does not match the initial location of the authentication device, the authentication device cuts off power to the volatile memory to erase the one or more private keys.

However Wheeler the apparatus wherein the authentication device stores the one or more private keys in volatile memory, wherein upon determination that the current location of the authentication device does not match the initial location of the authentication device, the authentication device cuts off power to the volatile memory to erase the one or more private keys(See 0146).

Therefore it would have been obvious to one ordinary skill in art at that time the invention was made to modify the teaching method of Wheeler within Karaoguz-Mackenzie-Niimura-Williams method in order to enhance security of the system.

Conclusion

28. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fikremariam Yalew whose telephone number is 5712723852. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 5712738300. The fax phone number for the organization where this application or proceeding is assigned is 571-272-4195.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

04/03/2009
/Fikremariam Yalew/
Examiner, Art Unit 2436

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit
2436